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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,514	10/12/2001	Darrell Meyer	344.07-US-1	3496
34284	7590	05/02/2006	EXAMINER	
ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			YIP, WINNIE S	
			ART UNIT	PAPER NUMBER
			3636	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/890,514	MEYER, DARRELL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Winnie Yip	3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 August 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 29-58 is/are pending in the application.  
 4a) Of the above claim(s) 43-56 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 29-40,42,57 and 58 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. In view of the appeal brief filed on August 8, 2005, PROSECUTION IS HEREBY REOPENED. A new grant of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
Peter M. Cuomo  
Supervisory Patent Examiner  
Technology Center 3600

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the claimed features “a plurality of spaced stabilizing members” and what elements and how these elements “stabilizing” the web of a chord as claimed must be clearly defined. It is not clear how “the punched out opening or the flange” provide the “spaced stabilizing member”. It is confusing how can “holes” stabilize an elongate member (i.e., a chord) as claimed.

***Claim Rejections - 35 USC § 112***

3. Claims 29-32 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification. Please note that an art rejection has been withheld pending clarification and correction of the drawing and specification objection. The application will be given full consideration on the merits of the claims upon such correction.

***Claim Rejections - 35 USC § 103***

4. Claims 29-37, 39-40, 42, and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buecker (US Patent No. 6,131,362) in view of Bodnar (US Patent No. 5,572,625).

Buecker shows and discloses a metal weight bearing beam (10) which is capable used as stud or a joist, said weight bearing beam (10) comprising two chords (12, 14) having a polygonal cross-section with 5 non-coplanar sides which has a shape of irregular pentagon as claimed, a web (16) connected and extending between vertexes of two angle of the chords, the web (16) having a plurality of spaced openings (74) which is capably formed by punching as

claimed, the openings provide a plurality of spaced stabilizing members as claimed, the web and the chords being fabricated from a single rolled sheet approximately 20-gauge steel (see col. 4, lines 10-21), each of the polygonal chord (12, 14) including two sides (20, 22; 36, 38) substantially parallel to the web and the sides having a height greater than a width of a base (18; 34), and the weight beam providing a span extending from end to end (50) being greater than its height (see Fig. 1). However, Buecker does not define the spaced openings (74) extending across more than half by less than all of the distance between the two chords as claimed. Bodnar teaches a metal weight bearing element (10) being used for a stud or a joint, the element including a web (12) connected between two L-shaped chords (16, 18), said web (12) having a plurality spaced openings (26) for allowing electrical wiring or plumbing passed through, wherein the openings being formed by punching out, therefore, with flanges (40) projecting outward the web and substantially normal to the span of the beam, wherein the openings (26) substantially extend at least forty percent of the area of the web for providing sufficiently area to allow the utility passed through, and the flanges (40) form trapezoidal members projecting outward from the web to provide stabilizing members for reducing the flexibility of the web of the beam and for achieving the load bearing desirable capacities. It would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the weight bearing beam of Buecker comprising the web having the plurality of spaced openings being punched out with flanges projecting outward from the web and openings and flanges having being larger with trapezoidal configuration that extending at least 40 percent of the area of the web as taught by Bodnar to provide stabilizing members on the web for reducing

flexibility of the beam and improving load bearing capacity to accommodate the construction requirement as desired for various applications.

5. Claims 29-31, 33-37, 39-40, 42, and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buecker (US Patent No. 6,131,362) in view of Daudet et al. (US Patent No. 6,301,854).

Buecker shows and discloses a metal weight bearing beam (10) which is capable used as stud or a joist , said weight bearing beam (10) comprising two chords (12, 14) having a polygonal cross-section with 5 no-coplanar sides which has a shape of irregular pentagon as claimed, a web (16) connected and extending between vertexes of two angle of the chords, the web (16) having a plurality of spaced openings (74) which is capably formed by punching as claimed, the openings provide a plurality of spaced stabilizing members as claimed, the web and the chords being fabricated from a single rolled sheet approximately 20-gauge steel (see col. 4, lines 10-21), each of the polygonal chord (12, 14) including two sides (20, 22; 36, 38) substantially parallel to the web and the sides having a height greater than a width of a base (18; 34), and the weight beam providing a span extending from end to end (50) being greater than its height (see Fig. 1). However, Buecker does not define the spaced openings (74) extending across more than half by less than all of the distance between the two chords and having flanges as claimed. Daudet et al. teaches a metal weight bearing element (40) being used as a joint or stud, the element including a web (42) connected between two L-shaped chords (44, 46), said web (42) having a plurality spaced openings (50) for allowing electrical wiring or plumbing passed through, wherein the opening (50) formed by punching and having a flange

(54) projecting outward the web and substantially normal to the span of the beam, wherein the openings (50) are formed substantially at least forty percent of the area of the web for sufficiently receiving the utility such as electrical wires and pipes as dependent upon the loading characteristics and the locations or size of the utility to be positioned, and having flanges for providing safer work environment to prevent inadvertent damage to the utilities that pass through the openings. It would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the weight bearing beam of Buecker comprising the web having the plurality of spaced openings being punched out with flanges projecting outward from the web and openings and flanges being larger than extend at least 40 percent of the area of the web as taught by Daudet et al. to provide openings with suitable size on the web to accommodate the loading characteristic of various applications as desired and having flanges for providing safer work environment as well as to prevent inadvertent damage to the ducts, utilities that pass through the openings.

6. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buecker '362 in view of Bodnar '625 or Daudet et al. '005 as applied to claim 29 above, and further in view of Brooks (US Patent No. 991,603) .

Buecker in view of Bodnar teach all the limitation of the claimed invention as explained and applied above rejections except that either Buecker or Bodnar or Daudet et al. do not teach the beam having at least one chord being filled with a fill material. Brooks teaches a beam comprising two triangular chords (20) being connected by a web (19), wherein the chords are filled by heat resisting material (75). It would have been obvious to one ordinary skill in the art

at the time the invention was made to modify the beam of Buecker combined with Bodnar or Daudet et al. having at least one chord being filled with suitable filling material such as heat resisting material as taught by Brooks for providing the beam with additional weight.

***Response to Argument***

7. Applicant's arguments filed August 8, 2005 have been fully considered.

First, in response to applicant's argument of that cited references fail to teach or suggest all of the limitations suggested by the applicant's invention, we agree that this is so, otherwise our rejection would have been entered under section U.S.C. 102 of the statute.

Second, applicant does not disclose that the web having openings extending in a specific distance between two chords and having flanges solves any stated problems or it for any particular purpose except for creating a desirable pattern (see specification, page 8). Therefore, the claimed invention would perform equally well with the web having larger openings with flanges extending outward which preferably by punching as taught by Buecker combined with Bodnar.

Third, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant claims a weight bearing element "such as a studs or joint".

Buecker, Bodnar , and Daudet et al. all teach a weight bearing element being used as a joint or a stud in a building construction. The references teach the weight bearing element having a web connected between two chords, even the chords having different cross-sections, and the chords each having openings for receiving utilities elements such as electrical wires and plums passed therethrough. And, Bodnar or Daudet et al. only used to teach a web of the element may formed with openings with flanges that may formed by method of punching, and the openings and flanges would forming larger trapezoidal-shaped openings such that to reduce the flexibility of the weigh bearing element which provides stabilizing members to solve the same problem of Buecker as claimed invention. Therefore, the beams of Bodnar and Buecker are considered being used in same art, and it would have been obvious to one ordinary skill in the art at the time the invention was made to combine the references of Buecker with Bodnar or Daudet el. al. to provide a weight bearing elements including features as claimed.

Therefore, new grant of rejection are provided.

*Citations*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gibson '772 teaches a metal stud comprising a web extending between two polygonal chords and the web having openings extending across more than half of the distance between the chords as similar to the claimed invention.

***Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
Art Unit 3636

wsy  
April 25, 2006